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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09:981,200	10/17/2001	Brad Johnson	01-724	5763
24319	7590	12/30/2003	EXAMINER	
LSI LOGIC CORPORATION 1621 BARBER LANE MS: D-106 LEGAL MILPITAS, CA 95035			ROBERT, RUSSELL MARC	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,200

Applicant(s)

JOHNSON, BRAD

Examiner

Russell M Kobert

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 14-17, 19-22 and 25 is/are rejected.
- 7) ☒ Claim(s) 5, 13, 18, 23, 24, 26 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

1. In view of Applicant's argument with respect to the rejection under 35 U.S.C. 112, Second Paragraph, that rejection is hereby withdrawn.

2. Applicant's arguments filed October 2, 2003 have been fully considered but they are not persuasive. Applicant's argue that Amemiya does not teach a vortex tube providing cool air to a semiconductor processing or testing device. However, a counter argument can also be made based on Amemiya's disclosure that "the vortex tube is a known mechanism which can generate a high-temperature gas of about 80°C and a low-temperature gas of about -30°C from a high-pressure gas (air) of , e.g., about 30°C," as disclosed in column 6, lines 14-17. Moreover, it is a well-known axiom in assessing patentability that a claimed apparatus is characterized by its structure and not its intended use. That is, "apparatus claims must be structurally distinguishable from the prior art." MPEP 2114. In *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In *Hewlett-Packard Co v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: "Apparatus claims cover what a device is, not what it does." (emphasis in original). That is, in an apparatus claim, if a prior art structure discloses all of the structural elements in the claim, as well as their relative juxtaposition, then it reads on the claim, regardless of whether or not the function for which the prior art structure was intended is the same as that of the claimed invention. Additonally the limitations of claims 2 and 11 are within the capable ranges of Amemiya as disclosed supra; the semiconductor processing

device includes a testing device (see column 1, lines 5-25) as described in claim 3; and a platen area or chuck top (see column 1, lines 59-61) as described in claims 6, 7, 14, 19 and 20. The limitation of ducting the first air exhaust as described in claim 9 is considered an inherent characteristic of the vortex tube assemblies of Amemiya or Peters. Moreover, Peters shows such an exhaust portion in Figure 1, as item 16 (see also column 2, lines 49-51). With respect to Applicant's argument that Peters does not disclose a means for testing a semiconductor device, that argument is respectfully traversed. Peters discloses such a device as a test fixture (see column 2, lines 26-27) used for testing semiconductor devices (see column 1, lines 7-10).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-12, 14-17, 19-22 and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Peters (4848090; see column 2, line 40-60).

5. Claims 1-4, 6-12, 14-17, 19-22 and 25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Amemiya (6249132; see column 5, lines 25-40, column 5, line 53 – column 6, line 20; see also claims 11-14).

6. The following is a statement of reasons for the indication of allowable subject matter:

Claims 5, 13, 18, 23, 24, 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant's argument that the applied prior art fails to show a manifold as further detailed in claims 5, 13, 18, 23 and 26 is persuasive.

The indication of allowable subject matter, noted supra, is understood to be predicated upon consideration of each of the claims as a whole, and not upon any specific elements of the claims.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (703) 308-5222. *Starting January 12, 2004, the new telephone number will be (571) 272-1963.*

The Examiner's Supervisor, Kammie Cuneo, can be reached at (703) 308-1233. *Starting January 12, 2004, the new telephone number will be (571) 272-1957.*

For an automated menu of Tech Center 2800 phone numbers call (571) 272-2800.



Russell M. Kobert
Patent Examiner
Group Art Unit 2829
December 16, 2003

William H. Zander
Dan A. Zander
Primary Examiner
12/16/3